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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

STARZL et al.

Serial No.: 10/084,632

Filed: February 25, 2002

Atty. File No.: 4724-2

For: "ENUMERATION METHOD OF  
ANALYTE DETECTION"Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450) Group Art Unit: 1641  
)  
) Examiner: Lum, Leon Yun Bon  
)  
) RESPONSE TO RESTRICTION  
) REQUIREMENT UNDER 35 C.F.R. §121  
)  
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TYPED OR PRINTED NAME: Barbara Tyndall

Dear Sir:

This is in response to the Office Action have a mailing date of September 21, 2004 regarding the above-referenced U.S. patent application. In the Office Action, the Examiner has found that the application claims are drawn to two sets of distinct inventions. These are method claims 1-19 (Group I) and apparatus claims 20-32 (Group II).

Applicants hereby traverse this Restriction Requirement. The Examiner finds that the apparatus as claimed can be used to practice another materially different process. The Examiner states that "the apparatus as claimed can be used to practice the materially different process of reading data of digital images that have been encoded onto a compact disk."

Both apparatus and method claims are drawn to making determinations related to a substance of interest. Both sets of claims require a control that processes digital image data based on light collected using a light collection device. Although both sets of claims do not require use of a compact disk having digital images encoded thereon for reading, not only can the apparatus as claimed read such data, but the method as claimed could also be practiced using

such a compact disk. Applicants therefor submit that this distinction related to use of a compact disk having digital images does not constitute a materially different process since neither method claims nor apparatus claims are precluded from incorporating such a feature. This conclusion is further supported by the practical factor that, based on the significant similarities between the content of the apparatus and method claims, both sets of claimed inventions would require essentially the same prior art searching. That is, it does not matter that the apparatus as claimed could be used to read such data on a compact disk, there would be substantial overlap in the prior art searching required for both sets of inventions so that virtually the same search effort would be undertaken for both method and apparatus claims.

Notwithstanding the traversal of this restriction requirement, Applicants hereby elect claims 1-19 of Group I for examination and with the understanding that Applicants have the right to file a divisional patent application directed to the unelected claims.

Respectfully submitted,

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